

Attorney Docket No. 9411-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Timothy Thronson et al.

Application No.: 10/811,709

Filed: March 29, 2004

For: **METHODS, SYSTEMS, AND COMPUTER PROGRAM PRODUCTS FOR
PROCESSING AND/OR PREPARING A TAX RETURN AND INITIATING
CERTAIN FINANCIAL TRANSACTIONS**

Confirmation No.: 1356

Group Art Unit: 3687

Examiner: Glass, Russell S

Date: September 7, 2010

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Commissioner for Patents
P.O. Box 1450
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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on September 7, 2010.

Signature: _____

Kirsten S. Carlos

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed July 7, 2010.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 50-0220.

I. The Examiner's Answer – Response to Argument

Appellants will refrain herein from readdressing all of the deficiencies with the pending rejections and, therefore, in the interest of brevity, Appellants hereby incorporate herein the arguments set out in Appellants' Brief on Appeal filed April 1, 2010 (hereinafter "Brief") as if set forth in their entirety. Accordingly, Appellants will only address new arguments made in the Examiner's Answer.

In the "Response to Argument" section beginning on page 15, the Examiner's Answer attempts to rebut Appellants' arguments set forth in Section II of the Brief. Appellants will respond to the arguments in the Examiner's Answer for this section below.

With respect to Appellants' argument in Section IIA that Regan fails to disclose a plurality of media formats, the Examiner's answer states that the PDF and HTML formats constitute a plurality of media formats. (Examiner's Answer, page 15). Appellants disagree and submit that one skilled in the art would interpret a media format as a particular data storage option. HTML is a language for Web pages and PDF is a file format. Neither HTML nor PDF define any type of media type, such as electronic, optical, magnetic, paper, etc. For example, both HTML and PDF files could be stored as electronic files, optical files, or magnetic files.

With respect to Appellants' argument in Section IIB that Regan fails to disclose presenting to a user multiple options for receiving value when a taxpayer is entitled to a refund, the Examiner's Answer states that Regan discloses that refunds can occur via ECF transfer or by a mailed check at col. 1, lines 25 – 36. (Examiner's Answer, page 16). This passage from Regan, however, does not include any disclosure or description of presenting multiple options to a user for receiving value, but simply states that the IRS can pay refunds by electronic funds transfer. The Examiner's Answer also cites FIG. 34 of Regan as disclosing that payment can occur via multiple options, such as credit card, electronic check, or EFT. (Examiner's Answer, page 16). These options, however, are options for an individual or business to pay a tax liability, not options for receiving value from the IRS—see FIGS. 33 and 34 of Regan.

With respect to Appellants' argument in Section IIC that Regan fails to disclose or suggest establishing an account with a financial institution if the taxpayer is entitled to a refund, the Examiner's Answer cites the U. S. Treasury's Automated Clearing House (ACH) system, which establishes transitory bank accounts for refund and payment processing and is referenced at col. 1, lines 25 – 36 of Regan. (Examiner's Answer, page 16). As explained in Section IIC of the Brief, a taxpayer must already have an account established with a financial institution for a refund to be paid by the ACH system. Thus, Regan fails to disclose establishing an account with a financial institution if the taxpayer is entitled to a refund.

With respect to Appellants' argument in Section IID that Regan fails to disclose scanning at least one financial document, the Examiner's Answer states that Regan discloses retrieving an electronic form and formatting the retrieved electronic form. Formatting the retrieved electronic form is alleged to be a form of scanning. (Examiner's Answer, page 16). Independent Claim 63, however, recites, in part:

scanning at least one financial document;
converting information on the at least one financial document into an
electronic format;

...

The Examiner's Answer ignores the recitation that the information on the scanned document is subsequently converted into an electronic format. Retrieval of an electronic form and formatting the retrieved form would not require any subsequent conversion into an electronic format. Thus, retrieving an electronic document and formatting the retrieved document cannot correspond to scanning at least one financial document as recited in independent Claim 63 because according to Claim 63 the scanned financial document is not in an electronic format, but information on the financial document is converted to an electronic format after scanning is complete.

The Examiner's Answer states that claim recitations such as "establishing an account with a financial institution if the taxpayer is entitled to a refund," "a refund options module that is configured to present that taxpayer with options for receiving value if the taxpayer is entitled to a refund," and "a payment options module that is configured to present the taxpayer with options for paying a tax if the taxpayer owes the tax" are conditional limitations that do not carry patentable weight as the action is only required when the condition is satisfied. (Examiner's Answer, page 16). Appellants disagree. It is common in the electrical, computer science, and business method arts to draft claims in which actions are taken based on particular conditions, such as value exceeding a threshold, a signal being received, a comparative result, etc. The aforementioned claim recitations clearly set forth the metes and bounds of particular inventions. In some cases, the claim language applies to situations in which a taxpayer is entitled to a refund. In some cases, the claim language applies to situations in which the taxpayer owes a tax. Appellants submit that the appropriate analysis is whether the prior art discloses or suggests the particular actions recited in the claims when the conditions are satisfied.

Appellants submit, therefore, that the cited references fail to disclose or suggest the recitations of Claims 1 – 44 and 46 – 69. Accordingly, Appellants respectfully request reversal of the rejection of Claims 1 – 44 and 46 – 69 based on the cited references.

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II. Conclusion

For at least the reasons set forth in above and in Appellants' Brief, Appellants request reversal of the rejections of the pending claims, allowance of the pending claims, and passing of the application to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Scott Moore". The signature is fluid and cursive, with the first name "D." being small and the last name "Moore" being larger and more prominent.

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